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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/201,107 | 11/30/1998 | CHRISTIAN MAYAUD | CM3-CON | 1150 |

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RUDEN, MCCLOSKY, SMITH, SCHUSTER & RUSSELL, P.A.
P.O. BOX 1900
FORT LAUDERDALE, FL 33301

| EXAMINER | |
|---|---|
| BLECK, CAROLYN M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3626 | |

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/201,107 | MAYAUD, CHRISTIAN | |
| | Examiner | Art Unit | |
| | Carolyn M. Bleck | 3626 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *71,73-75 and 85* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *71 and 73-75* is/are allowed.

6)☒ Claim(s) *85* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the amendment filed 30 March 2005. Claims 71-73, 75, and 85 are pending. Claims 71 and 85 have been amended.

### *Terminal Disclaimer*

2. The terminal disclaimer filed on 30 March 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 5,845,255 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Affidavit filed under 37 C.F.R. § 1.131*

3. The affidavit filed on 30 March 2005 under 37 CFR 1.131 is sufficient to overcome the Schrier et al. (US 6,317,719) reference.

## EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Robert Schwartz on 6/28/05.

The application has been amended as follows:

Claim 71, line 32, "may be" presented has been changed to "is" presented.

***Allowable Subject Matter***

5. The following is an examiner's statement of reasons for allowance: Claims 71-73 and 75 are directed towards a prescription creation software system providing a prescription creation screen display, permitting prescriber-operable data capture including: patient-identifying data; prescribed drug identification data; drug quantification data; information regarding prescribability of a drug pursuant to formulary guidelines, the information being formulary-qualified according to the patient condition; and a library of prescribable drug data accessible from the prescription creation screen to display multiple prescribable drugs; and drug formulary information identifying at least one of multiple drugs as a patient's drug formulary preferences to enable selection by the prescriber of a benefit plan recommended drug; by which the patient's drug formulary preference may be ' presented to the prescriber prior to completion of the prescription.

The Examiner applied Schrier et al. (US.6,317,719) under 35 U.S.C. § 102(e) as teaching the features of claim 71. Note Schrier's teachings of a prescription creation screen permitting prescriber operable data capture including patient id, prescribed drug, drug quantification, and patient condition (col. 13, lines 5-15, col. 6, lines 4-25, col. 8, lines 35-50, col. 9, lines 10-35), a library of prescribable drug data accessible from the

prescription creation screen to display multiple drugs (col. 5, lines 30-67, col. 13, lines 60 - col. 14, line 45)., a prescription output screen to output the completed prescription including patient condition, identification, and quantification (col. 13, lines 10-16). Schrier also teaches information regarding prescribability of the drug according to patient condition (col. 8, lines 35-60, col. 9, lines 35-65, col. 11, lines 30-40, col. 13, line 60 – col. 14, line 30); drug formulary information identifying at least one of multiple drugs as the patient's drug formulary preference (col. 13, line 60 – col. 14, line 30).

The Applicant filed an affidavit under 37 C.F.R. § 1.131 on March 30, 2005 swearing behind the Schrier reference. This affidavit has been deemed effective in removing Schrier as prior art. The Examiner has failed to find any applicable prior art with a filing date prior to December 13, 1993, which is the earliest effective filing date of the Schrier reference. For at least these reasons, claims 71 and 73-75 are deemed to be allowable over the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brimm et al. (5,072,383).

(A) As per claim 85, Brimm discloses a display screen (Fig. 5, col. 5 line 59 to col. 6 line 22) for a physician to enter an order, e.g., medication orders, wherein the order includes the patient's name, medication name, the dosage of the medication, and the patient's condition (such as for pain, see Fig. 6) (Fig. 5-6, col. 9 lines 1-42), a listing of medications for a physician to chose from by placing the cursor over the item, a terminal to output the orders (i.e., a prescription), wherein the orders includes the patient's condition and drug information and treatment information (Fig. 5-6, col. 9 lines 1-42).

Brimm does not expressly disclose a library of drugs. However, the Examiner respectfully submits that because a user is able to select the drug from a list, the name of the drug and other information about the drug would need to be stored in a computer (i.e., see the file server of Brimm, Fig. 2). Further, as per the amendment "wherein said prescribable drugs are associated with a patient condition," the Examienr respectfully submits that Fig. 6 displays the medication associated with the patient condition (see severe pain and restlessness) (See also, col. 9 line 8 to col. 10 line 62). The motivation being to quickly and easily retrieve organized information.

***Response to Arguments***

8. Applicant's arguments filed 30 March 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 30 March 2005.

At pages 16-17 of the response filed 30 March 2005, Applicant argues that the Brimm reference fails to teach the features of claim 85, namely the way prescribable drugs are listed.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., associating a patient condition *with a list* of prescribable drugs, prior to selecting prescribable drugs for the patient and "selectively list[ing] prescribable drugs that are specifically associated with a patient's medical condition") are not recited in the rejected claim(s). In particular, there is no requirement within claim 85, step b, that that patient condition be displayed or listed on a screen display. It is further noted that in general most prescribable drugs are associated with a patient condition (i.e., a prescribable drug is generally used to treat a patient condition, and thus is associated with it.) Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a method and

apparatus for coordinating medical procedures (4,489,387), computerized dispensing of medication (4,839,806), safety enhanced device and method for effecting application of a therapeutic agent (5,088,981), computer display system and method for facilitating access to patient data records in a medical information system (5,361,202), medical network management system and process (5,471,382), method and apparatus for coordinating concurrent updates to a medical information database (5,546,580), computerized healthcare accounts receivable purchasing collections securitization and management system (5,550,734 and 5,704,044), health care management system for managing medical treatments and comparing user-proposed and recommended resources required for treatment (5,583,758), flexible computer based pharmaceutical care cognitive services management system and method (5,666,492), method and system for constructing formulae for processing medical data (5,715,451), method and apparatus for clinical pathway order selection in a medical information system (5,740,800), interactive medication ordering system (5,758,095), and health care management system for comparing user-proposed and recommended resources required for treatment (5,953,705).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

(571) 273-6767 [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB
CB
June 28, 2005

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600